

O-113-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2424878  
BY DUNSTER HOUSE LTD TO REGISTER A SERIES OF THREE  
TRADE MARKS IN CLASS 28**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 95228 BY AMAZON EUROPE TECHNOLOGIES SCS**

## BACKGROUND

1) On 19 June 2006, Dunster House Ltd (hereafter Dunster), applied to register the following as a series of three trade marks:

Amazon  
AMAZON  
amazon

for a range of goods in Class 28.

2) Following examination, the application was accepted on the basis of honest concurrent use under the provisions of section 7(1) of the Trade Marks Act 1994 (the Act) for the following goods:

Children’s climbing frames made from timber; swings.

3) The application was published for Opposition purposes in Trade Marks Journal No.6675 on 9 March 2007, the publication including the following clause:

“Honest Concurrent use with Registration Nos M751641 (6442/13595), M756850 (6470) and others.”

4) On 22 May 2007, Amazon Europe Technologies SCS (hereafter Amazon), filed a notice of opposition. The Opposition is brought under sections 5(1), 5(2)(a) and 5(2)(b) of the Act, under which Amazon relies on the following trade mark:

Trade Mark	No.	Designation Date/IC Priority Date	Conferral of Protection Date	Relevant Goods (Class)
Amazon	M751641	15.09.2000 16.03.2000	08.11.2002	<b>28</b> - Games, playthings; scale model vehicles; gymnastic and sporting articles included in this class; decorations for Christmas trees.

5) On 28 June 2007, Dunster filed a counterstatement in which they say:

“The trademark which has been applied for is the name of a specific product – The “Amazon” climbing frame. It is not a company name, and will only apply to this one particular product”.

6) Only Amazon filed evidence in these proceedings. Neither side wished to be heard nor did either side file written submissions.

## **OPPONENT'S EVIDENCE**

7) This consists of a witness statement, dated 5 October 2007, from Tania Clark the opponent's Trade Mark Attorney. Her statement consists of submissions rather than evidence. As such, it is neither necessary or appropriate for me to summarise it here.

8) That concludes my summary of the evidence filed.

## **DECISION**

9) The Opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act. These read as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

10) An earlier right is defined in section 6 of the Act, the relevant parts of which state:

“6. - (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

11) Section 7 of the Act is also relevant and reads:

“7. - (1) This section applies where on an application for the registration of a trade mark it appears to the registrar-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, but the applicant shows to the satisfaction of the registrar that

there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purposes of this section “honest concurrent use” means such use in the United Kingdom, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of section 12(2) of the Trade Marks Act 1938.

(4) Nothing in this section affects-

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds, where no consent to registration).

(5) This section does not apply when there is an order in force under section 8 below.”

12) In these proceedings Amazon is relying on one trade mark i.e. international registration No. 751641 which has a date of designation in the United Kingdom of 15 September 2000 and for which a Priority date of 16 March 2000 stemming from a German registration was claimed; it clearly qualifies as an earlier trade mark under the above provisions. I note that conferral of protection was achieved on 8 November 2002. Given that the application in suit was published for opposition purposes on 9 March 2007, Amazon’s registration is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

### **Comparison of trade marks**

13) I turn first to the objection based on section 5(1) of the Act. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the ECJ said in relation to what constitutes an identical trade mark:

**“51** There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

**52** However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect

picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, [Case C-342/97 Lloyd Schuhfabrik Meyer \[1999\] E.C.R. I-3819](#) at para.[26]).

**53** Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

**54** In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

14) The respective trade marks at issue in these proceedings are as follows:

Applicant’s Trade Marks	Opponent’s Trade Mark
Amazon AMAZON amazon	Amazon

15) The applicant’s trade marks consist of the word Amazon presented in title, upper and lower case. The opponent’s trade mark is presented in title case. The first trade mark in the applicant’s series of three is therefore identical to the opponent’s trade mark. In so far as the other variations of the applicant’s trade marks are concerned, based on the guidance in *Sadas*, and in the words of the ECJ that:

“...insignificant differences between the sign and the trade mark may go unnoticed by an average consumer”,

16) I have no hesitation in concluding that all three variations of the applicant’s trade mark are identical to the opponent’s trade mark.

**Comparison of goods**

17) For the sake of convenience the respective goods at issue in these proceedings are as follows:

Applicant’s Goods	Opponent’s Goods
Children’s climbing frames made from timber; swings.	Games, playthings; scale model vehicles; gymnastic and sporting articles included in this class; decorations for Christmas trees.

18) There can be little dispute that the term “playthings” appearing in the opponent’s specification would include all of the goods specified in the applicant’s specification. In my view, the respective goods are therefore identical.

19) Under section 5(1) of the Act a trade mark shall not be registered if it is identical to an earlier trade mark and the goods which it is applied for are identical to the goods for which the earlier trade mark is protected. I noted above that the application proceeded to publication under section 7(1) of the Act on the basis of honest concurrent use, an approach which was permissible at the time the application was accepted. However, the applicant has not filed any evidence in these proceedings. Consequently, this is not a matter I need comment on any further.

20) I have concluded that both the trade marks and goods at issue in these proceedings are identical. The opposition based on section 5(1) of the Act succeeds accordingly. That being the case, there is no need for me to consider the additional grounds based on sections 5(2)(a) and (b) of the Act.

### **Costs**

21) The opponent has been successful and is entitled to a contribution towards its costs. I order the applicant to pay to the opponent the sum of £600. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17 day of April 2008**

**G W SALTHOUSE  
For the Registrar  
The Comptroller-General**